Remarks

Pending in the application are claims 1-42, of which claims 1, 8, 9, 10, 16, 24, 26, 30, 34 and 35 are independent. The following comments address all stated grounds for rejection, and the Applicant respectfully submits that the presently pending claims, as identified above, are now in a condition for allowance.

Claim Rejections - 35 U.S.C. 102

Claims 1, 8 and 9

Claims 1, 8 and 9 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0195729 ("the '729 reference"). Applicant respectfully traverses the rejection for the following reasons.

The claimed invention in independent claims 1, 8 and 9 identifies portions of a model as being either *critical to a real-time execution* of the model or *non-critical to a real-time execution* of the model. The claimed invention generates code that is capable of real-time execution based on the critical portions of the model.

The '729 reference relates to hardware implementation of graphical code.

Applicant respectfully submits that the cited reference fails to anticipate each and every element of the claimed invention. Applicant submits that the '729 reference fails to provide an enabling disclosure for the elements of claims 1, 8 and 9. In order to reject the claimed invention as not novel or anticipated by a reference under 35 U.S.C. §102, the reference must contain an enabling disclosure for the claimed invention. *In re Hoeksema*, 339 F.2d 267, 158 USPQ 596 (CCPA 1968).

The '729 reference discloses a hardware implementation of a graphical program. The '729 reference also discloses that a portion of the graphical program is compiled for execution by a CPU. The '729 reference further discloses that another portion of the graphical program is converted into a hardware implementation. (See, Abstract of the '729 reference). In particular, Fig. 4A of the '729 reference discloses creating a graphical program (step 302), compiling

'supervisory control and display portion' of the graphical program (step 322), and exporting at least a portion of the graphical program to 'a hardware description' (step 304).

In comparison, the claimed invention identifies portions of a model as being either *critical to a real-time execution* of the model or *non-critical to a real-time execution* of the model. Although claim 36 of the '729 reference includes a copy of claim 1 of the pending application, the simple copy of claim 1 of the pending application does not provide an enabling disclosure for identifying portions of a model as being either *critical to a real-time execution* of the model or *non-critical to a real-time execution* of the model, as recited in claims 1, 8 and 9. The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; merely naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm. Inc. V. Mayo Foundation for Medical and Education Research*, 346 F.3d 1051, 1054, 68 USPQ3d 1373, 1376 (Fed. Cir. 2003). Furthermore, the disclosure of the 'supervisory control and display portion' and 'hardware implementation portion' of the graphical program in the '729 reference cannot produce the claimed invention without undue experiment.

Additionally, Applicant submits that at least claim 36 of the '729 reference is not entitled to the benefit of the prior filing date of its patent applications, and therefore the '729 reference is not a qualified prior art reference. In the Office Action, the Examiner relies only on claim 36 of the '729 reference to reject claims 1, 8 and 9. A continuation application must meet the requirement of continuation of disclosure to have the benefit of the prior filing date of its parent applications. Claim 36 of the '729 reference must be for an invention disclosed in the manner provided by 35 U.S.C. §112, first paragraph, which requires enablement, best mode and description of the claimed invention. Under the enablement requirement, the disclosure must set forth sufficient information to enable a person in the relevant art to make and use the invention.

The first page of the '729 reference shows that the '729 reference was filed on May 9, 2003, which is a continuation of application No. 09/631,527 ("the first continuation application") filed on August 3, 2000, which is a continuation of application No. 08/912,445 filed on August 18, 1997. The first continuation application was filed with a new disclosure including Abstract to support a new set of claims.

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Applicant submits that the '729 reference does not provide sufficient information to enable a person in the relevant art to identify portions of a model as being either *critical to a real-time execution* of the model or *non-critical to a real-time execution* of the model, as recited in claim 36 of the '729 reference. The '729 reference discloses compiling the supervisory control and display portion of a graphical program, and exporting another portion of the graphical program to a hardware description. This disclosure does not provide an enabling disclosure for claim 36 of the '729 reference. Therefore, at least claim 36 of the '729 reference is not entitled to the benefit of the prior filing date of its patent applications, and the '729 reference is not a qualified prior art reference.

In particular, the '729 reference was filed on May 9, 2003 after the pending application was published on January 23, 2003. The '729 reference was filed just around three months after the pending application had been published. Applicants submit that there were ongoing patent litigations between the assignee of the '729 reference and the assignee of the pending application. The file history of the '729 reference shows that the '729 reference was filed with claim 36 in its original claim set that copies claim 1 of the pending application. It appears that the '729 reference was simply filed to include a copy of the claimed invention with the intention to prevent the pending application from being issued to a patent.

In light of the aforementioned arguments, Applicant respectfully submits that the '729 reference fails to disclose each and every element of independent claims 1, 8 and 9. Applicant therefore requests the Examiner withdraw the rejection of claims 1, 8 and 9 under 35 U.S.C. §102(e), and pass the claims to allowance.

Claims 10-42

Claims 10-42 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0196187 ("the '187 reference"). Applicant respectfully traverses the rejection for the following reasons.

The claimed invention in independent claims 10, 16, 24, 26, 30, 34, and 35, at least in part, specifies a model that include a first subset of sections designated *post processing unit*

sections, and a second subset of sections designated as *core processing unit sections*. The claimed invention generates code of the model using the second subset of sections.

The '187 reference relates to the execution of an application in an embedded system.

Applicant respectfully submits that the cited reference fails to anticipate each and every element of the claimed invention. Applicant submits that the '187 reference does not contain an enabling disclosure for the elements of claims 10, 16, 24, 26, 30, 34 and 35. The '187 reference discloses the execution of an application in an embedded system. The '187 reference discloses that a graphical program includes front panel source code and block diagram source code. (See, Fig. 9 of the '187 reference). The '187 reference also discloses that the front panel source code is executed in a host computer. The '187 reference further discloses that the block diagram source code is executed either in the host computer or in the embedded system.

In comparison, the claimed invention specifies a model that includes a first subset of sections designated *post processing unit sections*, and a second subset of sections designated as *core processing unit sections*. The '187 reference does not disclose post processing unit sections and core processing unit sections. The '187 reference therefore fails to enable one of ordinary skill in the art to specify a first subset of a graphical program designated post processing unit sections, and a second subset of sections of designated as core processing unit sections.

Additionally, Applicant submits that at least claims 23-26 of the '187 reference are not entitled to the benefit of the prior filing date of its parent applications, and therefore the '187 reference is not a qualified prior art reference. In the Office Action, the Examiner relies on claims 23-26 of the '187 reference to reject independent claims 10, 16, 24, 26, 34, and 35. Claim 23 of the '187 reference copies most of the limitations from claim 24 of the pending application. Claims 24-26 of the '187 reference depends on claim 23 of the '187 reference.

In particular, claim 23 of the '187 reference recites post processing unit sections and first processing unit sections that copy the post processing unit sections and core processing unit sections, respectively, from claim 24 of the pending application. Claim 23 of the '187 reference further recites that the post processing unit sections require *a lesser real-time response*, and the

first processing unit sections require *a greater real-time response*. The '187 reference, however, does not provide an enabling disclosure for post processing unit sections that require a lesser real-time response, as recited in claim 23 of the '187 reference. Also, the '187 reference does not provide an enabling disclosure for the first processing unit sections that require a grater real-time response, as recited in claim 23 of the '187 reference. Therefore, at least claims 23-26 of the '187 reference are not entitled to the benefit of prior filing date of its patent applications, and the '187 reference is not a qualified prior art reference.

Additionally, the '187 reference was filed on May 16, 2003 after the pending application was published on January 23, 2003. The '187 reference was filed just around three months after the pending application had been published. As argued above with reference to the '729 reference, Applicants submit that there were ongoing patent litigations between the assignee of the '187 reference and the assignee of the pending application. It appears that the '187 reference was simply filed to include claim 23 that copies claim 24 of the pending application with minor changes in order to prevent the pending application from being issued to a patent.

In light of the aforementioned arguments, Applicant respectfully submits that the '187 reference fails to disclose each and every element of independent claims 10, 16, 24, 26, 30, 34, and 35. Applicant therefore requests the Examiner withdraw the rejections of claims 10-42 under 35 U.S.C. §102(e), and pass the claims to allowance.

Claim Rejections - 35 U.S.C. 103

Claims 2-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over the '729 reference in view of the '187 reference. Applicant respectfully traverses the rejection for the following reasons.

Claims 2-7 depend from claim 1.

Applicant respectfully submits that the cited prior references fail to teach or suggest all of the limitations of claim 2-7. Applicant submits that the '729 and '187 references fail to provide an enabling disclosure of the limitations in claims 2-7. As described above, the '729 and '187 references include copies of claims of the pending application. The copies of the
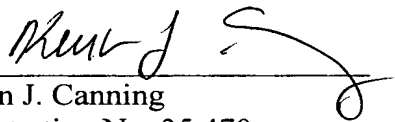
claims, however, do not provide enabling disclosure of the limitations recited in claims 2-7. Therefore Applicant submits that cited prior references fail to teach or suggest all of the limitations of claim 2-7.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. If, however, the Examiner considers that further obstacles to allowance of these claims persist, we invite a telephone call to Applicant's representative.

Dated: October 8, 2004   Respectfully submitted,

By _____
Kevin J. Canning
Registration No. 35,470
LAHIVE & COCKFIELD, LLP
28 State Street
Boston, Massachusetts 02109
(617) 227-7400
(617) 742-4214 (Fax)
Attorney for Applicant